

## REMARKS

### I. Status of the claims

After entering this amendment, claims 90-103 will be pending. Applicants cancelled claims 52-89 without prejudice or disclaimer for being directed to non-elected subject matter. Applicants added new claims 99-103. Claims 99-101 find support, for example, in paragraph 100 of the published application. Claims 102 and 103 find support, for example, in paragraph 123 of the published application.

### II. Rejections under 35 U.S.C. § 112, second paragraph

The Office rejected claims 90-98 under 35 U.S.C. § 112, second paragraph for allegedly being indefinite. Applicants respectfully traverse this rejection.

The Office argues that the term “initial pressure” in claim 90 is “indefinite and unclear in scope.” Office Action at 2. The Office asks “[w]hat is the final internal pressure?” and “how can one distinguish a package having this claimed parameter over a similarly constructed package that ‘lost’ its negative internal pressure or never had a negative pressure to begin with?”

In reply, Applicants note the term “initial pressure” is defined in the specification as “the pressure at the time the chamber was first sealed.” Specification at ¶ 104 of the published application. As long the initial pressure in a bale is less than ambient atmospheric pressure, and the rest of the claim limitations are met, such bale would be within the scope of the instant claims. Knowledge of the final pressure is not necessary, and there is nothing ambiguous or confusing in this determination.

Likewise, if a bale meets the claim limitations but subsequently loses the initial vacuum and the internal pressure is no longer less than ambient atmospheric pressure, such bale would still be within the scope of the claims. Analogously, a bale that did not have an initial pressure of less than ambient atmospheric pressure would fall outside of the scope of the instant claims. Again, there is nothing ambiguous about these determinations. Applicants remind the Office that “[t]he primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent.” M.P.E.P. § 2173. One of ordinary skill in the art having prepared a bale and trying to determine whether such bale infringes the instant claims would be able to make that determination easily.

Therefore, the phrase “initial pressure in the sealed chamber” in the claims is definite and Applicants respectfully request that this rejection be withdrawn.

### **III. Rejections under 35 U.S.C. § 102/103**

#### ***Dunbar***

The Office rejected claims 90-98 under 35 U.S.C. § 102 as allegedly anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 3,458,966 (“*Dunbar*”).

The Office argues that the package in Figure 2 of *Dunbar* “has a substantially cuboidal shape. . . with walls depicted as substantially flat.” Office Action at 3. The Office argues that the only distinction between claim 90 and the embodiment in *Dunbar*’s figure is the limitation regarding the density of the bulk material in the sealed chamber. *Id.* According to the Office, “[w]hen the reference discloses all the limitations

of a claim except a property or function, . . . [the Office] has a basis for shifting the burden of proof to applicant.” *Id.* (citing *In re Fitzgerald*, 205 U.S.P.Q. 594 (CCPA 1980), and M.P.E.P. §§ 2112 to 2112.02. Applicants respectfully traverse this rejection.

***Dunbar’s packages are not substantially flat***

Contrary to the Office’s assertion, *Dunbar* does not disclose all of the limitations of the instant claims. The depiction in Figure 2 of *Dunbar* represents a bale of fibrous material *before, or at best, during* the application of vacuum, as demonstrated by the fact that the bale has not been compressed enough to fit in the sleeve (33). As such, the bale in *Dunbar’s* Figure 2 does not have an initial pressure in the *sealed* chamber less than ambient atmospheric pressure, as instantly claimed. As mentioned above, the initial pressure is measured at the time the chamber is first sealed. Specification at ¶ 104. The bale depicted in *Dunbar’s* Figure 2 has not been sealed.

Moreover, *Dunbar’s* bale would not have top and bottom walls that are substantially flat even after the bale is sealed. *Dunbar* explains:

“the [packaged] material is compressed according to the density of the material at a given point. That is, if the stacks or rolls happen to be less dense at one point than another, the less dense points compress more and *the package takes the best configuration possible according to the ‘give’ at various points within the compressible material.*

*Dunbar* at col. 6, lines 68-74 (emphasis added). Therefore, the walls of *Dunbar’s* sealed chamber would have bulges and depressions, which would depend on the local density of the fibers being packed. Accordingly, *Dunbar* does not disclose a packaged bale wherein the top and bottom walls of the sealed chamber are substantially flat. For at least this reason, *Dunbar* does not anticipate nor render obvious the instant invention. Accordingly, Applicants respectfully request that this rejection be withdrawn.

***Dunbar does not inherently anticipate the invention***

In addition to the foregoing remarks, Applicants present this independent argument against the instant rejection.

The Office cited *In re Fitzgerald* and M.P.E.P. § 2112 *et seq.* to support the notion that if a “reference discloses all the limitations of a claim except a property or function” the Office can shift the burden to Applicants to prove that the reference does not anticipate the claims. However, before shifting the burden of proof to Applicants, the Office is required to “present[] evidence or reasoning tending to show inherency.” M.P.E.P. § 2112.V. That is, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” M.P.E.P. § 2112.IV. The Office has not met this burden. By the Office’s own admission, the Office “cannot determine whether or not [the invention] is anticipated or merely an obvious matter of design choice over the disclosure of Dunbar.” Office Action at 3. However, other than this acknowledgement, the Office has not provided a “basis in fact and/or technical reasoning” to show that the recited density range *necessarily flows* from the teachings of *Dunbar*.

“The mere fact that a certain thing may result from a given set of circumstances *is not sufficient.*” M.P.E.P. § 2112.IV (internal citations omitted, emphasis added). “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter *is necessarily present* in the thing described in the reference. . . Inherency, however, may not be established by probabilities or possibilities.” *Id.* (internal citations omitted, emphasis added).

As mentioned above, *Dunbar* does not meet all of the limitations of the instant claims, at least because it does not disclose bales with substantially flat top and bottom walls. Therefore, the Office cannot argue that because *Dunbar* meets all other limitations of the instant claims, the packed density in *Dunbar's* bales must be the same as in Applicants' bales. The facts in this case do not support an inference of inherency.

**Reliance on inherency to shift burden to applicants is misplaced**

Reliance on *In re Fitzgerald* is equally misplaced. *In re Fitzgerald* is directed to the analysis of product-by-process claims where a claimed property regarding polymer crystallization shrinkage was found to be an exclusive function of the method steps followed to prepare the polymer (cooldown rate of the polymer during crystallization). *In re Fitzgerald*, 205 U.S.P.Q. at 596-597. That is, the inherent limitation necessarily arose from practicing the process steps in the prior art reference. *In re Fitzgerald* is consistent with the other M.P.E.P. sections cited by the Office, which require that the inherent property or function necessarily flows from the structure, composition, or process steps recited in the prior art. See, e.g., M.P.E.P. § 2112.IV. As mentioned above, the Office has not explained how the limitation regarding the density of the bulk material in the sealed chamber would necessarily flow from *Dunbar's* teachings.

**The Office has not made a *prima facie* case of obviousness**

The Office has not supported the allegation that the density is "an obvious matter of design choice." Foremost, there is no disclosure in *Dunbar* of the density of the material packed in any of *Dunbar's* bales. Therefore, *Dunbar* provides no guidance to one of ordinary skill in the art with respect to a desirable density range. *Dunbar* does not use the density of the packed material as a parameter that would control or

influence the process of preparing bales. The Office is respectfully reminded that only result-effective variables can be optimized. M.P.E.P. § 2144.05.II.B.

The Office has not proved that packed density is a result-effective variable that drives the design of bales. Moreover, the Office has failed to explain why one of ordinary skill in the art would have chosen to make bales with the density recited in the instant claims. For at least this reason, the Office has not made a *prima facie* case of obviousness. Accordingly, Applicants respectfully request that this rejection be withdrawn.

#### **Claims 97 and 98**

With respect to claims 97 and 98, the Office argues that “the degree of ‘flatness’ of the top wall would have been a matter of routine skill in order to achieve a high degree[] of flatness to permit stacking of the bales one atop of another.” Office Action at 4. Applicants respectfully traverse this rejection. The Office has not provided any evidence to support the notion that one of ordinary skill in the art would have been able to achieve the degree of flatness recited in claims 97 and 98 and still meet the rest of the limitations in claim 90, from which they depend.

Foremost, as explained above, *Dunbar* does not disclose bales with substantially flat walls. Therefore, *Dunbar* does not support this rejection. Additionally, the Office has failed to consider that bales with the recited degree of flatness are not produced by the state of the art. For example, the specification explains that when using the securing devices of the prior art, “[m]aterials on either side of the securing device are only partially restrained and tend to exhibit spring back causing the bale to bulge in portions between adjacent securing devices. The overall bale acquires a non uniform

rounded shape.” Specification at ¶ 6. At best, the Office has suggested why one of ordinary skill in the art would want to have a flat bale. However, the Office has not explained how, absent the present specification, one of ordinary skill in the art would have been able to produce a bale with the recited characteristics.

In light of these remarks, Applicants respectfully request that this rejection be withdrawn.

#### **IV. Rejections under 35 U.S.C. § 103**

##### **CH 256382 in view of *Dunbar***

The Office rejected claims 90-98 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Swiss Patent No. 256382 (CH 256382) in view of *Dunbar*.

The Office argues that CH 256382 “discloses the desirability of packaging cellulose fibers in compressed bulk packages of 61 x 91 cm weighing between 1.8 to 4 kg.” Office Action at 4. The Office argues that “[t]his converts to 0.32 g/cm<sup>3</sup> to 0.72 g/cm<sup>3</sup> density per cm thickness of material well within the claimed parameters.” *Id.* According to the Office, it would have been obvious to one of ordinary skill in the art to modify the package of CH 256382 “by packaging the compressed fibers in cuboidal shape by the manner suggested by *Dunbar*.” *Id.* Applicants respectfully traverse this rejection.

The rejection is in error for at least each of the following *independent* reasons:

##### **1. Even if combined, the resulting bale would not meet all of the limitations of the instant claims**

As mentioned previously, *Dunbar* does not disclose that the top and bottom walls of the sealed chamber are substantially flat. On the contrary, *Dunbar* discloses that the

bales would have bulges and depressions according to the local density of the packaged fibers. Therefore, even if combined, the cited references would fail to meet all of the limitations of the present claims.

**2. CH 256382 does not disclose a packed density of 0.32 g/cm<sup>3</sup> to 0.72 g/cm<sup>3</sup>**

The Office argues that CH 256382 discloses “0.32 g/cm<sup>3</sup> to 0.72 g/cm<sup>3</sup> *density per cm* thickness of material.” Office Action at 4 (emphasis added). Respectfully, the Office’s calculations are incorrect. CH 256382 discloses that “[f]or example, let us assume that the weight of 480 individual sheets, measuring 61 x 91 cm, varies between 1.8 and 4 kg.” CH 256382 at 1 (emphasis added). As recognized by the Office, CH 256382 does not disclose the volume of the stacked sheets, which is necessary to calculate density (density = weight/volume). CH 256382 only discloses the area of the sheets being packaged, but not the height of the stack. The Office, however, improperly assumed that the height of the 480 stacked sheets was one centimeter because the Office used *the total weight* of the 480 sheets in its calculation. CH 256382 does not support such assumption. CH 256382 does not disclose the height of the stack of 480 individual sheets, nor the weight per cm of stacked sheets. Therefore, CH 256382 does not disclose, explicitly or implicitly, the recited density 0.32 g/cm<sup>3</sup> to 0.72 g/cm<sup>3</sup>. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Applicants note that it is highly unlikely that the stack of 480 sheets weighing between 1.8 and 4 kg has a height of one centimeter. The sheets are creped, which causes ridge-like ribs on the paper. CH 256382 at bottom of p. 2. That is, the sheets are not flat. By comparison, a ream of 500 flat sheets of paper (such as common



printing paper) has a height of about 5 cm. The height of 480 *creped* sheets will be significantly higher.

**3. The divergent nature of the references does not suggest its combination**

CH 256382 is drawn to packaging of cellulose *sheets* useful for their properties in the absorption of liquids. CH 256382 at 7. In contrast, *Dunbar* is directed to the packaging of bulk *fibers*. Also, CH 256382 uses exclusively mechanical compression of the creped sheets. CH 256382 at 2. On the other hand, *Dunbar* uses exclusively vacuum to package the fibers. Clearly, CH 256382 and *Dunbar* are drawn to different purposes and the Office has not explained why one of ordinary skill in the art would combine the divergent teachings of the references.

The Office is respectfully reminded that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01.III (internal citations omitted, emphasis added). The Office has not met this burden.

In view of the foregoing remarks, Applicants respectfully request that this rejection be withdrawn.

**V. Conclusions**

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Office, placing the pending claims in condition for allowance. The proposed new claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, because all of the elements and their

relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Office.

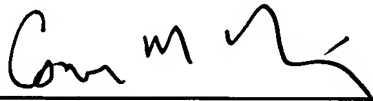
Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. The entry of the Amendment would allow Applicants to reply to the final rejections and place the application in condition for allowance. Finally, the entry of the amendment would also place the application in better form for appeal, should the Office dispute the patentability of the pending claims.

In view of the foregoing remarks, the claimed invention is neither anticipated nor rendered obvious in view of the cited prior art references. Applicants therefore request the entry of this Amendment, the Office's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: April 30, 2007